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In re Application of	:	
Britton et al.	:	
Application No.: 10/565,296	:	DECISION
PCT No.: PCT/US04/24308	:	
Int. Filing Date: 27 July 2004	:	ON
Priority Date: 28 July 2003	:	
Attorney Docket No.: PR60351USW	:	PETITION
For: Chemical Compounds	:	

This is in response to the petition under 37 CFR 1.47(a) filed on 20 January 2006.

### **BACKGROUND**

This international application was filed on 27 July 2004, claimed an earlier priority date of 28 July 2003, and designated the U.S. The 30 month time period for paying the basic national fee in the United States expired at midnight on 28 January 2006. Applicants filed *inter alia* the basic national fee and the instant petition on 20 January 2006.

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(h), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor.

Regarding requirement (1), the \$200.00 petition fee is being charged to Deposit Account No. 07-1392, per the Transmittal Letter filed on 20 January 2006.

Regarding requirement (2), petitioner urges that the absence on the declaration of the signature of joint inventor Jonathan Britton be excused because he "cannot be found or reached despite diligent efforts." Counsel's attention is respectfully drawn to MPEP 409.03(d), which states in part:

Where inability to find or reach a nonsigning inventor "after diligent effort" is the reason for filing under 37 CFR 1.47, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a diligent effort was made. The fact that a nonsigning inventor is on vacation or out of town and is therefore temporarily unavailable to sign the declaration is not an acceptable reason for filing under 37 CFR 1.47. Furthermore, the fact that an inventor is hospitalized and/or is not conscious is not an acceptable reason for filing under 37

CFR 1.47. 37 CFR 1.43 may be available under these circumstances. See MPEP § 409.02. Such a petition under 37 CFR 1.47 will be dismissed as inappropriate. The statement of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein. Statements based on hearsay will not normally be accepted. Copies of documentary evidence such as internet searches, certified mail return receipts, cover letters of instructions, telegrams, that support a finding that the nonsigning inventor could not be found or reached should be made part of the statement. The steps taken to locate the whereabouts of the nonsigning inventor should be included >in the< statement of facts. It is important that the statement contain facts as opposed to conclusions.

To support the request for relief on the basis that Mr. Britton allegedly cannot be found or reached after diligent effort, counsel states that GSK sent certain correspondence to Mr. Britton's last known address on 22 September 2004, allegedly including a copy of the application and a declaration. Counsel further states that GSK sent correspondence to Mr. Britton's attorney on October 13, 2004, allegedly including a copy of the application and a declaration. Although petitioner has included copies of letters sent to Mr. Britton and to Keith O. Gregory, Esq., as well as DHL "tracking results" for correspondence sent to Mr. Britton, the petition lacks a statement of the pertinent facts by a person having first-hand knowledge of the facts recounted (since the correspondence was allegedly sent by GSK, not petitioner). It should also be noted that the letter to Keith Gregory accompanying the petition does not state that a complete copy of the application (specification, claims and drawings) was enclosed; instead, it merely referred to a "specification."

Petitioner characterizes the return correspondence received from the office of Keith Gregory as stating that the law office as "no longer aware of the whereabouts of Mr. Britton," but the copy of the letter accompanying the petition merely states that the law office had "lost contact with this client," not that his location was unknown. Although counsel's petition for relief is made on the basis that Mr. Britton cannot be found or reached after diligent effort, the petition does not recount any additional efforts which may have been undertaken to attempt to locate him, such as internet searches, telephone directory searches or skip trace searches, much less provide any documentary evidence of such searches. Based on the totality of the present record, it would not be appropriate to conclude that Mr. Britton "could not be found or reached after diligent effort" within the meaning of 37 CFR 1.47(a).

The petition further states that "In the alternative, Applicant requests that this Petition be accepted under 35 U.S.C. § 118" on the basis of potential irreparable harm to GSK, to whom "Mr. Britton was and is [allegedly] under an obligation to assign the above-referenced patent application." 35 U.S.C. 118 provides that

Whenever an inventor refuses to execute an application for patent, or cannot be found or reached after diligent effort, a person to whom the inventor has assigned or agreed in writing to assign the invention or who otherwise shows sufficient proprietary interest in the matter justifying such action, may make application for patent on behalf of and as agent for the inventor on proof of the pertinent facts and a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage; and the Director may grant a patent to such inventor upon such notice to him as the Director deems sufficient, and on compliance with such regulations as he prescribes.

Although counsel seeks "alternative" relief under 35 U.S.C. 118, that statute specifically empowers the Director to "grant a patent to such inventor upon such notice to him as the

Director deems sufficient, and on compliance with such regulations as he prescribes.” The specific regulation prescribed by the Director and pertinent to the fact pattern at hand is 37 CFR 1.47(a). Therefore, no “alternative” venue for relief is available under 35 U.S.C. 118.

Regarding requirement (3), the petition includes a statement the last known addresses of Mr. Britton. Accordingly, requirement (3) has been satisfied.

Regarding requirement (4), inspection of the declaration filed on 20 January 2006 reveals that it nominates an inventor named “KATAMREDDY,” whereas the published international application nominates an inventor named “KALAMREDDY.” No explanation of this discrepancy appears to be present in the application file. As such, it would not be appropriate to accept said declaration at this time. Accordingly, requirement (4) has not been satisfied.

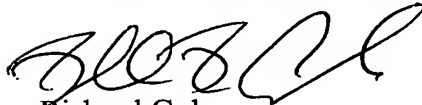
### **DECISION**

The petition under 37 CFR 1.47(a) is **DISMISSED**, without prejudice.

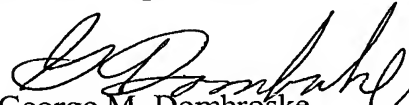
If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled “Renewed Petition Under 37 CFR 1.47.” No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response will result in **ABANDONMENT**.

The \$200.00 petition fee is being charged to counsel’s Deposit Account No. 07-1392, as authorized by the Transmittal Letter filed on 20 January 2006.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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